

Attorney Docket No. LEAP:128US
U.S. Patent Application No. 10/811,346
Reply to Office Action of October 11, 2005
Date: December 12, 2005

Remarks

Objections to Claims 20 and 26

The Examiner asserts that language of Claim 20 and 26 claiming that two adjust means and two removable adjustment knobs are located on opposite sides of the microscope leaves open the possibility that the two adjustment means are separate from the two removable adjustment knobs. Although Applicant disagrees with the Examiner, Applicant has amended Claim 20 to read, “two focus adjustment means, each having a removable focus adjustment knob, disposed on opposite sides of said microscope.”

Claim 26 reads, “The microscope of Claim 22 wherein said first and second focus drive means are disposed on opposite sides of said microscope.” This claim language is not ambiguous. Claim 26 has not been amended since any ambiguity regarding the first and second focus drive means was removed by the amendments to Claim 22, from which Claim 26 depends. Claim 22 clearly states that the “first and second removable focus adjustment knobs are releasably and alternatively fastenable to either of said first and second focus drive means.” That the focus adjustment knobs are releasably fastenable to either of said first and second focus drive indicates that knobs can be separated from the drive means, but that the knobs are associated with the drive means. The Applicant claims a microscope with a focus drive means that can be releasably fastenable to a removable focus adjustment knob. To change that language would extract the essence of the invention from the claim, i.e., interchangeability.

Applicant courteously requests that the objections be removed.

The § 102 (f) Rejections of Claims 1-3, 5-7, 9,11 and 12

The Examiner rejected the above referenced claims under 35 U.S.C. 102 (f) because the applicant did not invent the claimed subject matter and that the claimed subject matter is disclosed in United States Published Patent Application No. US 2004/0246571 (Bonaventura). The Examiner also stated that Bonaventura has a different inventive entity as the current application. Applicant assumes that the Examiner meant to state that the subject invention and Bonaventura have the same inventive entity. The Examiner also state that Bonaventure has not

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been assigned, while the current application is assigned to Leica Microsystems Wetzlar GmbH. Applicant respectfully traverses the rejection.

Claim 1

Bonaventura does not teach, suggest, or motivate the following elements of Claim 1: a removable interchangeable focus adjustment knob magnetically fastenable to a focus adjustment means. Magnetic tool (12) is described in paragraph [0022] of Bonaventura as tool to align the objectives of a microscope. Alignment of objectives is certainly not the same as adjusting the focus of a microscope, which is what the claimed removable interchangeable focus adjustment knob is capable of doing when it is magnetically fastened to the focus adjustment means. Magnetic tool (12) is not equivalent to the subject matter in Claim 1. In paragraph [0023] there is no reference to a removable interchangeable focus adjustment knob connected to a focus adjustment means, and certainly there is no reference to those two components being magnetically fastenable to each other.

Bonaventura does not teach the invention of Claim 1. Claims 2 and 3, dependent from Claim 1, enjoy the same distinction from Bonaventura.

Claim 5

Bonaventura does not teach, suggest, or motivate the following elements of Claim 5: “a focus adjustment means and a removable interchangeable focus adjustment knob, said focus adjustment knob is magnetically fastenable to said focus adjustment means.” Magnetic tool (12) is described in paragraph [0022] of Bonaventura as tool to align the objectives of a microscope. Alignment of objectives is certainly not the same as adjusting the focus of a microscope, which is what the claimed removable interchangeable focus adjustment knob is capable of doing when it is magnetically fastened to the focus adjustment means. Magnetic tool (12) is not equivalent to the subject matter in Claim 5. In paragraph [0023] there is no reference to a removable interchangeable focus adjustment knob connected to a focus adjustment means, and certainly there is no reference to those two components being magnetically fastenable to each other.

Bonaventura does not teach the invention of Claim 5. Claims 6 and 7, dependent from Claim 5, enjoy the same distinction from Bonaventura.

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Claim 12

Claim 12 recites a focus adjustment means comprising a focus adjustment knob and a removable focus adjustment knob that are coaxial and independently rotatable with respect to each other. Bonaventura fails to teach, suggest, or motivate the preceding elements of Claim 12. Instead, Bonaventura discloses a microscope tool (12) for aligning objectives comprising a handle (26) and a tip (18) that are fixedly attached. It is impossible for the tip and the handle to rotate independently because they are fixedly attached. Since the microscope tool (12) disclosed in Bonaventura is comprised of one piece (i.e., handle (26) and tip (18) are fused) Bonaventura cannot have two separate parts, i.e., a focus adjustment knob and a removable focus adjustment knob that is rotate independently.

Inventorship

Applicant has shown that Bonaventura does not teach, suggest, or motivate the invention recited in Claims 1, 5, or 12, and subsequently, any claims depending from Claims 1, 5, and 12. Therefore, inventorship under 35 U.S.C. 102 (f) for the subject invention and Bonaventura is moot.

Assignment

Bonaventura has been assigned to Leica Microsystems as is indicated in the print out from PAIR that is attached in the **Appendix**.

The § 103(a) Rejections of Claims 4, 8 10 and 13-32

The Examiner rejected the above referenced claims under 35 U.S.C. 103(a) as being unpatentable over Bonaventura (US 2004/0246571) due to obviousness. Applicant respectfully traverses the rejection.

In the absence of an obviousness rejection of Claims 1, 5, and 12 it is presumed that those claims have been deemed nonobvious by the Examiner and thus all claims dependent from those nonobvious independent claims are nonobvious as well. Specifically, Claims 10 and 13-21. In

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view of the foregoing remarks, reconsideration and withdrawal of the rejections of Claims 10 and 13-22 as being obvious in view of Bonaventura is courteously requested.

Claim 22

Paragraph [0022] or [0023] of Bonaventura contain no teaching or suggestion of a focus drive means or a removable focus adjustment knob as recited in Claim 22. Bonaventura discloses a microscope tool (12) with an adjusting tip (18) and a handle (24), but it is explicitly stated that tool (12) is used to align the objectives of a microscope (paragraph [0022]). Alignment is defined as centering on the same axis, while focus is defined as adjusting a lens to make the image appear sharp and well defined. The claimed interchangeable focus adjustment knob of the subject application is not for aligning the objectives, but it is for focusing the objectives. Thus, there are significant structural and functional differences between tool (12) and the focus adjustment knob.

Claim 22 is patentable over Bonaventura. Claims 22-26, dependent from Claim 22, enjoy the same distinction with respect to Bonaventura. Applicant courteously requests that the rejection be removed.

Claim 22

Bonaventura describes a magnetic tool holder that comprises a borehole (24) formed in housing (14) with magnet (20) adhered to the bottom of borehole (24). The borehole is designed as a holder for tool (12) which can be inserted into borehole (24) and held in place by magnet (20) at the bottom of the hole. Bonaventura does not teach, suggest, or motivate the removable fine focus adjustment knobs that are releasably and alternatively fastenable to a focus drive means as recited in Claim 27. The Examiner has applied impermissible hindsight to arrive at the rejection.

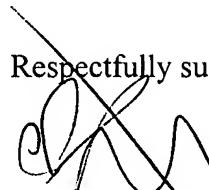
Claim 27 is patentable over Bonaventura. Claims 28-32, dependent from Claim 27, enjoy the same distinction with respect to Bonaventura. Applicant courteously requests that the rejection be removed.

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Conclusion

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

~~Respectfully submitted,~~


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Attachments

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Appendix



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